

REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 26-49 are currently pending, of which claims 26, 37, 37, and 43 are amended. The Examiner is respectfully requested to reconsider her rejections in view of the Amendments and Remarks as set forth hereinbelow.

Examiner Interview

If, during further examination of the present application, any further discussion with the Applicants' Representative would advance the prosecution of the present application, the Examiner is encouraged to contact Carl T. Thomsen, at 1-703-208-4030 (direct line) at his convenience.

Rejections Under 35 U.S.C. §§ 102 & 103

Claims 26-32, 35-43, 46 and 47 stand rejected under 35 U.S.C. § 102(e) as anticipated by Ferre et al. (U.S. 6,694,167).

Claims 33, 34, 44, 45, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ferre et al. in view of Anthony (U.S. 6,758,218).

These rejections are respectfully traversed.

Amendments to Independent claims 26 and 37

While not conceding the appropriateness of the Examiner's rejection, but merely to advance the prosecution of the present application, **independent claim 26** has been amended to recite a combination of elements directed to a stereostatic device, including *inter alia*

“means for securing the frame to a head of the subject so as not to immobilize the head of the subject,

wherein the stereostatic device is configured to contact the subject at only one point of contact on a front of a face of the subject, and is configured so that frame stays immobile during any facial movements of the subject.”

In addition, **independent claim 37** has been amended to recite *inter alia*
“securing said stereostatic frame to a head of the subject so as not to immobilize the head of the subject; ...

wherein the stereostatic device is configured to contact the subject at only one point of contact of a front of a face of the subject, and is configured so that frame stays immobile during any facial movements of the subject.”

Support for the novel features above can be found at least in paragraph [0011] of the original specification.

One of the key advantages of the arrangement of the present invention is that a patients facial movements do not affect the tracking of the frame. This is because during facial movements, the nasion does not move. The advantage of this is increased reliability in tracking as well as increased comfort to the patient, as they do not have to restrict movements of their face to provide accurate measurements.

Comments Regarding Ferre et al.

First of all, the Applicant reminds the Examiner that the Ferre et al. reference discloses multiple alternative and distinct embodiments in FIGS. 1-32.

Once again, the Applicants respectfully disagree with the Examiner's rejection.

As can be seen in Ferre et al. column 4, lines 11-26 and FIGS. 1-4, 18, 19, 28, this document merely discloses a head set 12 provided with two ear mounts 28 on left and right side members 30 (which extend across the patient's forehead, above and to the rear of the eyes, and down to the ears), and a nose bridge 32 on a center member 34 extending downwardly from a point above the eyes at a center of the forehead and passing between the patient's eyes. Thus, the head set 12 of Ferre et al. contacts the forehead, both sides of the head, the two ears, and portions of the face above and between the two eyes. In other words, the Ferre et al. device is supported by multiple contact points on the front of the face. Additionally, unlike the present invention, the Ferre et al. device is not capable of remaining immobile during facial movements of the subject.

As argued previously, it is unreasonable and not proper for the Examiner to select a single portion (namely, center member 34) of the head set 12, as disclosing the frame 3 of the present invention.

The center member 34 (even if considered alone, which is not proper) fails to teach or suggest the frame 3 of the present invention. As pointed out above, center member 34

extends downwardly from a point above the eyes at a center of the forehead and passes between the patient's eyes.

Secondly, the Examiner refers to markers 116 on center plate 102 of center member 34 of the alternative and distinct embodiment shown in FIG. 18-19.

As the Examiner knows well, it is not proper to combine features from two distinct alternative embodiments, such as the embodiment in FIGS 1-4 and the embodiment in FIGS 18-19.

Further, neither the embodiment shown in FIGS 1-4, nor the alternative embodiment shown in FIGS 18-19, can teach or suggest:

“(means for) securing the frame to a head of the subject so as not to immobilize the head of the subject, ...

wherein the stereostatic device is configured to contact the subject at only one point of contact on a front of a face of the subject, and is configured so that frame stays immobile during any facial movements of the subject,” as set forth in **independent claims 26 and 37**.

If the Examiner continues to believe that the Ferre et al. reference discloses the subject matter set forth in each of **independent claims 26 and 37**, she is respectfully requested to provide specific evidence to support her position.

Otherwise, the rejection based on the disclosure of Ferre et al. should be withdrawn.

Inherency Test Not Met

As the Examiner knows well, a prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Ferre et al. reference fails to disclose the subject matter of **independent claims 26 and 37**.

Regarding Anthony

As argued previously, the Anthony was cited in the rejection of dependent claims 33, 34, 44, 45, 48, and 49 merely to disclose a supporting element 30 forming a closed loop.

As such, Anthony fails to overcome the deficiencies of Ferre et al. in order to arrive at the subject matter of **independent claims 26 and 37**

Accordingly, it is respectfully submitted that **independent claims 26 and 37** and each of the claims depending therefrom are allowable.

Dependent Claims

The Examiner will note that dependent claims 32 and 43 have been amended to further clarify the claimed invention.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

All pending claims are now in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §102(e) and 103(a) are respectfully requested.

CONCLUSION

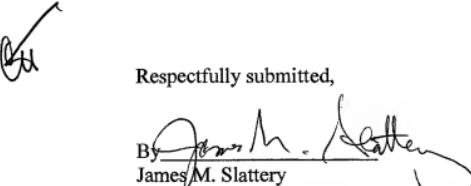
In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Carl T. Thomsen, Reg. No. 50786 at (703) 208-4030 (direct line) in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-1448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly extension of time fees.

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Respectfully submitted,

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